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Serial No. 09/940,805
Docket No. 58880/278

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Applicant: H. Wurster et al.
Application No.: 09/940,805
Title: Integrated Decorator Coupler and Food Decorating Assembly
Filing Date: August 29, 2001
Art Unit: 1761
Examiner: S. Weinstein

Mail Stop Appeal Brief-Patents

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REPLY BRIEF

SIR:

Appellants respectfully submit this Reply Brief in response to the Examiner's Answer of March 15, 2007. Claims 1-12 and 14-20 are pending in the present application and stand rejected. Appellants maintain their original arguments as presented in the Appeal Brief. The following specific points are in response to supplemental arguments and a new rejection provided by the Examiner in the Examiner's Answer.

Rejection of Claims 1-12 and 14-20 Under §103(a)

The Examiner sets forth a new ground of rejection in the Examiner's Answer. Specifically, the Examiner asserts the same references as asserted in the previous rejection (the primary reference being U.S. Patent No. 6,153,238 to Shannon ("Shannon")) but adds a new reference, U.S. Patent No. 5,104,013 to Hawley ("Hawley"). Although in the field of caulking, the Examiner asserts that "Hawley nevertheless discloses it was conventional to provide a plurality of thread containing extruder nozzles or tips having differently sized outlet openings so that one nozzle could be associated with another to change an aspect of the extruded material." (See Examiner's Answer, page 8). However, such a device is fundamentally different than the integrated coupler recited by the present claims and the teachings of Hawley would not motivate one skilled in the art modify the couplers in the art into an integrated coupler.

Hawley is directed to a series of sequentially attachable couplers that are used to obtain a desired caulking diameter. Hawley does not describe the use of a single coupler that serves both as a tip for extruding caulk and as a single coupler to attach different tips. Rather, Hawley describes a tip and a plurality of couplers, each one of the plurality of couplers placed over the immediately proximal coupler. For example, Hawley states that a first reducing coupling is attachable to the caulking tube nozzle, a second reducing coupling is attachable to the first reducing coupling, and a third reducing coupling is attachable to the second reducing coupling. (See col. 3, lines 9-33). If anything, Hawley would motivate one skilled in the art to use multiple couplers, not a single integrated coupler.

As Appellants have stated before, the Examiner fails to provide a reasonable basis that one of ordinary skill in the art would have had the requisite motivation to substitute the circular opening of Shannon's coupler with a non-circular decorative opening. Not only is there a lack of motivation in the art, but the use of a non-circular decorative opening actually runs counter to the intended purpose of Shannon's coupler. The courts have held that there is no motivation to modify a reference when the suggested combination of references would require "a change in the basic principle under which the

[primary reference] construction was designed to operate.” (In re Ratti, 270 F. 2d 810, 813, 123 USPQ 349, 352 (CCPA 1959)).

Shannon’s coupler, like all of the couplers in the other cited references, shows a large circular opening. (As used herein, a “large” circular opening means an opening on a coupler that is larger than the decorative opening of an attached tip). The primary purpose, if not the only purpose, of the opening of the couplers in the cited art is to allow filling (such as icing) to flow from a bag, through the opening and through an attached decorative tip with a minimum amount of effort by the user. To minimize the resistance to the flow of the filling through the device, the opening of the coupler should be circular and should be the same size or larger than the decorative opening of the tip. (See Wurster Declaration, filed April 25, 2006, paragraph 4).

Accordingly, the couplers cited by the examiner always describe large circular openings. This indicates that the design of their couplers is dictated by the desired function of allowing filling to flow to a tip with a minimum amount of resistance. For example, as shown in Exhibit A of Appellant’s Appeal Brief, the diameter D of the adapter 141 of Shannon shown in FIG. 5 is larger than the diameter d the decorative tip 40 shown in FIG. 4. Nothing in any of the cited references suggests any reason or desirability for a coupler to have a non-circular opening.

The use of a non-circular decorative opening as recited in claim 1, for example, necessarily increases the amount of resistance of the opening, thereby running counter to the intended purpose of the couplers of the prior art. Thus, there is motivation for one of ordinary skill in the art not to modify the circular openings of the prior art couplers to a non-circular decorative shape.

In addition, Examiner’s Answer identifies no motivation for one of skill in the art to take a first decorative tip, such as that shown in Figure 7 of Shannon, and modify it to allow it to accept a second decorative tip on top of the first decorative tip. Indeed, despite offering two different solutions to the problem of delivering decoratively shaped filling (i.e., by using a decorative tip or a coupler for exchanging multiple tips), Shannon failed to figure out how to modify and combine these two embodiments to achieve the improved solution of the present invention.

The specification and claims use “decorative tip” consistently with its well understood meaning in the art, viz., a tapered extension for extruding filling. See, e.g., claims 1 and 3. The Examiner’s Answer repeatedly misconstrues “decorative tip” by equating it to any outlet. See, e.g., Examiner’s Answer, p. 13 (“a non-circular decorative tip (which is, after all, in reality or functionally, a nozzle outlet) . . .”). The outlet of Knight, for example, is not a decorative tip.

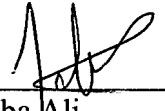
For at least these reasons, Appellants submit that claim 1-12 and 14-20 are not rendered obvious by Shannon in view of the other secondary and tertiary references.

Conclusion of Argument

Appellants maintain that the cited references neither individually nor collectively render obvious the appealed claims. Appellants respectfully submit that the rejections of the pending claims should be reversed.

Respectfully submitted,

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